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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,771	11/20/2000	Ana Silvia Sanchez	10001339-1	8288

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FORT COLLINS, CO 80527-2400

EXAMINER

MOSLEHI, FARHOOD

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 01/28/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,771

Applicant(s)

SANCHEZ, ANA SILVIA

Examiner

Farhood Moslehi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 6-10, 12-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Carcerano et al. (6,308,205) (hereinafter Carcerano).
4. AS per claim 1, Carcerano discusses a method for configuring a network device for intercommunication with a network, the network device being communicatively coupled with the network and having a first network configuration enabling the network device to communicate with the network, said method comprising the steps of: recording information corresponding to the first network configuration of the network device (e.g. col. 2, lines 12-20); determining

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whether the network device is able to communicate with the network (e.g. col. 1, lines 62-67); and if the network device is not able to communicate with the network, reconfiguring the network device such that a current network configuration of the network device corresponds to the first network configuration (e.g. col. 14, lines 15-22).

5. As per claim 10, it is rejected for similar reasons as stated above.
6. As per claim 12, it is rejected for similar reasons as stated above.
7. As per claim 2, Carcerano teaches the method, wherein information corresponding to the network configuration of the network device is maintained by a network card of the network device (e.g. col. 12, lines 12-19).
8. As per claim 13, it is rejected for similar reasons as stated above.
9. As per claim 3, Carcerano teaches the method wherein the step of determining whether the network device is able to communicate with the network comprises the step of automatically determining whether the network device is able to communicate with the network comprises the step of automatically determining whether the network device is able to communicate with the network (e.g. col. 9, lines 15-21. It is an inherent property of polling network devices to check for connectivity of devices to the network and to take appropriate action should the connection be disrupted).
10. As per claim 6, Carcerano shows the method, wherein the network device is a printer (e.g. col. 4, lines 28-35).
11. As per claim 16, it is rejected for similar reasons as stated above.
12. As per claim 7, Carcerano teaches the method, wherein the network has a server communicatively coupled thereto, and wherein the step of recording information corresponding

to the first network configuration of the network device further comprises the step of storing the information on the server (e.g. col. 5, lines 59-66).

13. As per claim 14, it is rejected for similar reasons as stated above.

14. As per claim 8, Carcerano teaches the method, wherein the network has a workstation communicatively coupled thereto, and wherein the step of recording information corresponding to the first network configuration of the network device further comprises the step of storing the information at the workstation (e.g. col. 4, lines 27-35).

15. As per claim 9, Carcerano shows the method, wherein the step of reconfiguring the network device comprises the step of reconfiguring the network card of the network device such that a current network configuration of the network device corresponds to the first network configuration (e.g. col. 4, lines 8-21).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carcerano in view of Roberts et al (5,960,167) (hereinafter Roberts).

18. As per claim 4, Carcerano does not specifically teach the method, wherein the step of reconfiguring the network device comprises the step of automatically reconfiguring the network device such that a current network configuration of the network device corresponds to the first network configuration if it is determined that the network device is not able to communicate with

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the network. Roberts teaches the method, wherein the step of reconfiguring the network device comprises the step of automatically reconfiguring the network device such that a current network configuration of the network device corresponds to the first network configuration if it is determined that the network device is not able to communicate with the network (e.g. col. 5, lines 1-20. Installing a new network device such as a printer with its automatic configuration is inherently similar to not being able to communicate for a number of reasons.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Carcerano with Roberts. The motivation would have been to incorporate a fail-over system.

19. Claims 5, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carcerano in view of Marbry et al (5,692,111) (hereinafter Marbry).

20. As per claim 5, Carcerano does not specifically teach the method, further comprising the steps of:

Determining whether the current network configuration of the network device corresponds to the first network configuration; and if the current network configuration of the network device does not correspond to the first network configuration, recording the current network configuration as a second network configuration such that, if it is determined that the network device is not able to communicate with the network, the network device may be reconfigured with the second network configuration. Marbry teaches the method, further comprising the steps of:

Determining whether the current network configuration of the network device corresponds to the first network configuration (e.g. col. 1, lines 39-42); and if the current network configuration of the network device does not correspond to the first network configuration, recording the current network configuration as a second network configuration such that, if it is determined that the

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network device is not able to communicate with the network, the network device may be reconfigured with the second network configuration (e.g. col. 1, lines 42-54). It would have been obvious to one of ordinary art at the time the invention was made to combine Carcerano and Marbry. The motivation would have been for network devices to work with multiple networks running different platforms.

21. As per claim 11, it is rejected for similar reasons as stated above.

22. As per claim 15, it is rejected for similar reasons as stated above.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application Publication Number 2002/0049693 to Case.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farhood Moslehi whose telephone number is 703-305-8646.

The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 703-305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

fm



**JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
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